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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/714,987	09/17/1996	HUGH SHARKEY	17616-705	4099

21971 7590 06/27/2002

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EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 06/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	08/714,983	Applicant(s)	Shankay
Examiner	d-shay	Group Art Unit	3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

Responsive to communication(s) filed on April 10, 2002.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

Claim(s) 45-55 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 45-55 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

## Office Action Summary

The examiner notes the cancellation of claims 56-73.

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 45 and 46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification is silent regarding having the geometry of the distal portion of the energy delivering device as an input.
3. Claims 47-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sand ('709) in combination with Makower et al. Sand ('709) teaches a device for shrinking collagen with thermal feedback. Makower et al teach a device for heating tissue with microwaves or electrical resistance and with temperature sensors located on an insulator. It would have been obvious to the artisan of ordinary skill to employ a device as taught by Makower et al in the device of Sand ('709), since Sand ('709) teach no particular configuration of the device for shrinking non-corneal collagen, thus producing a device such as claimed.
4. Applicant arguments have been fully considered, but the rejections have been maintained for the following reasons. While the examiner notes the cited passages in the originally filed disclosure, there is no support therein for the input to the computer program of the probe geometry as claimed, nor is there an enabling description of what

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form the input would take or how it would be processed by any program that would receive such input. Thus the rejection of claims 45 and 46 as based on an insufficient disclosure under 35 USC 112 first paragraph has been maintained.

5. Regarding the obviousness rejection, applicant points to the feedback control section of claim 47 asserting that this is not taught by the combination. This argument fails to two reasons. Firstly the functional recitations in claim 47 are not in proper form to provide a structural limitation under 35 USC 112, sixth paragraph (see the June 25, 2000 edition of the Official Gazette). Secondly, even if such recitations were the proper form Makower et al clearly discuss controlling the temperature of the tissue while Sand ('709) equally clearly teaches computer control of the applied energy. Thus these arguments are not convincing.

6. This is a Continuation Prosecution Application of applicant's earlier Application No. 08/714,987. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

David Shay:bhw

June 21, 2001

DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330

